

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

Date: Nov. 17, 2009

Applicants: Bednorz et al.

Docket: YO987-074BZ

Serial No.: 08/479,810

Group Art Unit: 1751

Filed: June 7, 1995

Examiner: M. Kopec

Appeal No. 2009-003320

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION  
TEMPERATURE, METHODS FOR THEIR USE AND PREPARATION

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**REQUEST TO REOPEN PROSECUTION  
UNDER**

**37 C.F.R. § 41.50 (a)(2)(i)**

**Or**

**37 C.F.R. § 41.50 (b)(2)**

**IN RESPONSE TO DECISION ON APPEAL  
DATED 09/17/2009**

Sir: Please consider the following.

Pursuant to 37 C.F.R. § 41.50 (a)(2)(i) or 37 C.F.R. § 41.50 (b)(2)

Appellants request that prosecution be reopened in response to the Decision on  
Appeal dated 09/17/2009 (Board's Decision).

**LIST OF  
ACRONYMS AND ABBREVIATIONS  
USED IN THIS PAPER**

The Following acronyms or abbreviated names are used in this paper:

1. **BD** or **Board's Decision** for the Decision on Appeal dated 09/17/2009;
2. **FA** or **Final Action** for the final rejection in the Office Action dated 10/20/2005 which is the final rejection which is being appealed;
3. **OA07282004** for the Office Action dated 07/28/2004.
4. **TFA** or **Total Final Action** for the combination of the Final Action and OA07282004 which is incorporated in the Final Action at page 4.
5. **BV1** for Appellants' Brief Volume 1 filed May 15, 2008;
6. **BV2** for Appellants' Brief Volume 1 filed May 15, 2008;
7. **BV3** for Appellants' Brief Volume 1 filed May 15, 2008;
8. **BV4** for Appellants' Brief Volume 1 filed May 15, 2008;
9. **BV5** for Appellants' Brief Volume 1 filed May 15, 2008;
10. **APPELLANTS' BRIEF** for AB1, AB2, AB3, AB\$ and AB5 collectively.
11. **EA** or **Examiner's Answer** for the Examiner's Answer mailed August 20, 2008;
12. **RB** for the Reply Brief filed 20 October 2008;
13. **RBS1** for the Reply Brief Supplement 1 filed October 21, 2008;
14. **RBS2** for the Reply Brief Supplement 2 filed October 28, 2008;
15. **RBS3** for the Reply Brief Supplement 3 filed November 6, 2008.
16. **Appellants' Replies** for RB, RB1, RB2 and RB3 collectively; and
17. **TOH** for the Transcript of the Oral Hearing held 10 June 2009.

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## REMARKS

### Section 1

Pursuant to 37 C.F.R. § 41.50 (a)(2)(i) or 37 C.F.R. § 41.50 (b)(2) Appellants request that prosecution be reopened in response to the Decision on Appeal dated 09/17/2009 (Board's Decision).

The paragraph bridging pages 42 and 43 of the Decision states (This is referred to herein as the Limitations on Appellant's Argument in a Request for Rehearing):

#### Notice Regarding Any Request for Rehearing

Any request for rehearing of this decision under 37 C.F.R. § 41.52 must be limited to points of fact and/or law which Appellants believe were overlooked or misapprehended in rendering this Decision. "Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section." 37 C.F.R. § 41.52(a)(1) (2007). In any request for rehearing,

Appellants must state with particularity each point of law or fact they believe was overlooked or misapprehended, must argue in support of each point, and must refer with particularity to where the argument was made originally in the appeal brief or reply brief(s).

Appellants request the prosecution be reopened since the Board's Decision depends on:

1. facts from Appellants' specification;
2. court decisions, and
3. arguments based on these facts and court decisions and other arguments that were not relied on by the Examiner in support of any rejection throughout the entire prosecution of the present Application or in any of the Ancestral Applications (as identified at ABV1 page 2 last paragraph), in particular, that

were not relied on by the Examiner in the Final Action or the Examiner's Answer in support of the rejections under 35 U.S.C. 112, first paragraph, for lack of enablement. A list of these facts, decisions and arguments are provided below

It is Appellants' position these new facts, decisions and arguments constitute new grounds for rejection or should be considered as new grounds for rejection. This is Appellants' position even though these new facts, decisions and arguments were presented and made in the Board's Decision in support of the same 35 U.S.C. 112 first paragraph rejections for lack of enablement of the Final Action.

Appellants' request that prosecution of the present application be reopened is proper and should be granted. Further support for Appellants' request can be found in a presentation made by Michael R. Flemming, Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (the Board) at a luncheon meeting of the New York Intellectual Property Law Association on September 16, 2009 (NYIPL Meeting). The presentation is entitled "Appellate Practice and Recent Developments Board of Patent Appeals and Interferences." Judge Flemming handed out a copy of his presentation. A copy is attached to this paper as Attachment #1.

- I. During his presentation Judge Flemming stated that if a decision on appeal of the Board sustains an appealed rejection of a final office action for different reasons than stated in the final office action that should be considered a new ground of rejection permitting the appellant to request and be granted that prosecution of the application be reopened.
- II. Judge Flemming further stated that in a decision on appeal of a panel of the Board in its appellate capacity is supposed to be considering:
  - a. the facts, decisions and arguments that the examiner gave in support of the rejection in the final office action and in the examiner's answer,
  - b. the facts, decisions and arguments that the appellant gave in the brief and reply in support of why the examiner made an error in the rejection in the final office action, and

- c. based on items a and b deciding whether to sustain the examiner's rejection or to reverse the examiner's rejection.
- III. Judge Flemming further stated that in a decision on appeal if the panel of the Board relies on the facts, decisions and arguments not referred in the final office action and in the examiner's answer, the panel of the Board is acting in such a situation as an examiner and prosecution of the application should be reopened at the request of the appellant. In this situation the panel of the Board is acting in the capacity of an examiner and has effectively withdrawn the final rejection.
- IV. Judge Flemming further stated that a panel of the Board should not in a decision on appeal make comments that may call into question the validity or patentability of claims not finally rejected by the examiner, but should only enter new grounds for rejection in response to which the appellant can request that prosecution of the application be reopened.

The copy of Judge Flemming's presentation is in Attachment #1 does not explicitly state what is stated above in items I, II, III and IV. (This shall be referred to herein as Proper Grounds for Requesting Prosecution be Reopened or PGRPR.) Attachment #2 is a declaration of Appellant's representative, Daniel P. Morris, stating that he was present at the NYIPL Meeting and that what is stated above in items I, II, III and IV is what he recollected Judge Flemming stated. Attachment #3 is a declaration of Alvin Joseph Riddles stating that he was present at the NYIPL Meeting and that what is stated above in items I, II, III and IV is what he recollected Judge Flemming stated.

The Limitations on Appellant's Argument in a Request for Rehearing prevent Appellants from introducing new facts, arguments, court or Board decisions, and documentary, affidavit or declaration evidence to rebut the new facts, decisions and arguments presented by the Board in its Decision on Appeal. Since the Board's Decision relies on facts, decisions and arguments not in the Total Final Action. Thus, Appellants respectfully submit that the Board's Decision is more in the nature of an action on the merits than it is a decision on appeal. For these reason Appellants request that prosecution be reopened



should be granted and Appellants respectfully request that this request be granted.

Appellants note Appellants' Reply states at page 5, lines 4-5. "[t]he Examiners' Answer is essentially verbatim copied from the Office Action dated 07/28/2004 and the Final Action." Thus the Examiner's Answer adds no new facts, decisions or arguments not found in the Total Final Action.

## **Section 2**

### **Section 2.1**

#### **THE BOARDS' DECISION CALLS INTO QUESTION THE VALIDITY OR PATENTABILITY OF A CLAIM NOT FINALLY REJECTED BY THE EXAMINER**

Footnote 4 at page 7 of The Board's Decision states:

Claims 138 and 326/138 are not included in the Examiner's rejection and therefore are not on appeal and are not under our jurisdiction. Nevertheless, we observe that these claims are not limited to the subject matter described as enabled in the Answer (or in this Opinion). Under these circumstances, the Examiner's failure to include claims 138 and 326/138 in the § 112, first paragraph, rejection before us appears to be an inadvertent oversight.

Footnote 4 clearly states that "[c]laims 138 and 326/138 are not included in the Examiner's rejection and therefore are not on appeal and are not under [the Board's] jurisdiction." Footnote 4 clearly calls into question the validity of claims 138 and 326/138 not rejected by the examiner and thus not under the Board's jurisdiction. Consistent with the Proper Grounds for Requesting Prosecution be Reopened, Appellants request this application be returned to prosecution so that the Examiner can reject this claim for the reason given in the Board's Decision if the Examiner agrees with the Board's comments. Appellants would then have the opportunity to respond if such a rejection was made.

## **Section 2.2**

### **THE BOARDS' DECISION RAISES A 35 U.S.C. 112, SECOND PARAGRAPH REJECTION WITHOUT EXPLICITLY STATING A NEW GROUNDS FOR REJECTION**

The Board's Decision in footnote 5 at page 22 states:

Dependent claim 35 further defines "the composition" of parent independent claim 34. The claim 34 phrase "the composition" lacks strict antecedent basis due to an apparent oversight by Appellants. Consistent with the record before us (e.g., see independent claim 33), a person with ordinary skill in this art would regard claim 34 as providing strict antecedent basis for the phrase "the composition" by interpreting the claim 34 preamble "A superconducting apparatus having a superconducting onset temperature" as though it reads "A superconducting apparatus comprising a composition having a superconducting onset temperature". This is the interpretation we have given to parent claim 34 in assessing the enablement of dependent claim 35.

The Board's Decision is stating that claim 35 is indefinite under 35 U.S.C. 112, second paragraph. This is new grounds for rejection. Consistent with the "Proper Grounds for Requesting Prosecution be Reopened", Appellants request the Board to reject claim 35 under 35 U.S.C. 112, second paragraph and to grant Appellants' request to reopen prosecution or to return this application to prosecution so that the Examiner can reject this claim under 35 U.S.C. 112, second paragraph, for the effective reason given in the Board's Decision if the Examiner agrees with the Board's comments. Appellants would then have the opportunity to respond if such a rejection was made.

## **Section 2.3**

### **THE BOARDS' DECISION DOES NOT PROVIDE THE REQUIRED CLAIM CONSTRUCTION FOR THE "means for conducting a superconductive current" CLAIM LIMITATION OF CLAIMS 438, 440 and 536**

The last paragraph of BV1 page 43 states:

In Claims 438, 440 and 536 the "means for conducting a superconductive current" is in means plus function form. MPEP § 2181 Part II states "35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language 'shall be construed to cover the corresponding structure described in the specification and equivalents thereof.'"

Claims 438, 440 and 536 have been rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Appellants have appealed this rejection. The Board's Decision does not provide a construction of the limitation "means for conducting a superconductive current". The Board is required to give this means plus function limitation a construction. Without the required construction Appellants do not know what meaning the Board considers this limitation to have and thus cannot in a Request for Rehearing or appeal to the Court of Appeals for the Federal Circuit respond to or rebut the Board's Decision sustaining the Examiner's rejection of these claims. The Examiner in the Total Final Action and Examiner's Answer did not give this mean plus function limitation a construction. This is required. In *In re Donaldson* the CAFC states:

the PTO was required by statute to look to [the appellant's] specification and construe the "means" language recited in the ... claim ... as limited to the corresponding structure disclosed in the specification and equivalents thereof.

*In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994).

In *in re Freeman* the CAFC states citing *In re Donaldson*:

Claim construction is a question of law which we review de novo. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)

*In re Freeman*, 30 F.3d 1459, 1464 (Fed. Cir. 1994).

In *in re Baker Hughes* the CAFC states citing *In re Freeman*:

claim construction by the PTO is a question of law that we review de novo, see *In re Freeman*, 30 F.3d 1459, 1464, 31

*In re Baker Hughes Inc.*, 215 F.3d 1297, 1301, 55 USPQ2d 1149, 1152 (Fed. Cir. 2000).

In *Gechter v. Davidson* the CAFC states:

[T]he Board's opinion lacks a claim construction ... [T]he Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review. ... Claim construction must also be explicit, at least as to any construction disputed by parties to the interference (or an applicant or patentee in an ex parte proceeding).

*Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997).

Appellants request the Board to provide its construction of the limitation "means for conducting a superconductive current" in claims 438, 440 and 536 as required by the cited decisions and to grant Appellants' request to reopen prosecution so that Appellants can properly respond to this rejection.

The only comment that the Board's Decision make in regard to claims 438, 440 and 536 is in the last paragraph of page 23 and the first paragraph of page 24 which states

Initially, we address Appellants' argument that the Examiner's rejection of claims 438, 440, and 536 should be reversed because these claims recite "means for conducting a superconductive current", and therefore, "since the Examiner has allowed claims to specific examples in the specification, the claims in means plus function form can not be rejected as not being enabled" (App. Br., vol. 1, para. bridging 43-44). This argument is based on the proposition that claims 438, 440, and 536, because of their means plus function form, have the same scope as the claims which are considered to be enabled by the Examiner (i.e., claims in which the superconductor materials comprise (1) transition metal oxides in combination with (2) rare earth or rare earth-like or group III B elements, and (3) alkaline earth or group IIA elements).

This argument is unconvincing. As Appellants acknowledged during the Oral Hearing of 10 June 2009, the sixth paragraph of 35 U.S.C. § 112 requires that the means plus function language of the claims under review cover not only the corresponding structure or material described in the Specification but also the equivalents thereof whereby these claims are broader

than those considered to be enabled by the Examiner (*see* Hearing Transcript 3-5). Therefore, the mere fact that the Examiner considers more narrow claims to be enabled is an inadequate reason to consider broader claims 438, 440, and 536 to be enabled. It follows that this argument reveals no error in the Examiner's rejection of these claims.

This does not contain a construction of the limitation ""means for conducting a superconductive current."

#### **Section 2.4**

#### **GENENTECH'S "NOVEL ASPECT" ISSUE**

Appellants note that the Board's Decision relies on the statement "[i]t is the Specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement". *Genentech*, 108 F.3d at 1366, but does not identify what the Board considers to be the novel feature. It is not possible for Appellant to respond without knowing what the Board considers to be the novel feature. Appellants request that the Board grant Appellants' request to reopen prosecution and state what the Board considers the novel feature to be.

#### **Section 3**

#### **FACTS RELIED ON BY THE BOARD THAT WERE NOT CITED BY THE EXAMINER IN THE TOTAL FINAL ACTION OR THE EXAMINER'S ANSWER**

#### **Section 3.1**

The Boards Decision at pages 7-8 under the heading "Findings of Fact" and under subheading "The Specification" states:

As Background Art (Spec. 1), the Specification discloses that prior art superconductors include transition metal compounds and compositions such as Nb<sub>3</sub>Ge which exhibits a T<sub>c</sub> of about 23°K at ambient pressure (Spec. 3). **Prior art superconductors also include oxides such as the Li-Ti-O system with superconducting onsets as high as 13.7°K (Spec. para., bridging 3-4). (We take official notice that Li is an alkali element and that Ti is a transition metal.)** According to the Specification, "[t]hese materials have multiple crystallographic phases including a spinel structure exhibiting the high T<sub>c</sub>[,] and [o]ther metallic oxides, such as the perovskite Ba-Pb-Bi-O system[,] can exhibit superconductivity due to high electron-phonon coupling in a mixed valent compound" (*id.*).

Neither the Total Final Action nor the Examiner's Answer refer to or relies on the parts of Appellants' Specification referred to by the Board in the passage quoted above, that is, not in bold font. The Board's Decision does not indicate where the Total Final Action or Examiner's Answer refers to or relies on the parts of Appellants' Specification referred to by the Board in the passage quoted above.

### Section 3.2

The Boards Decision at page 8, line 3 to page 10, line 6 under the heading "Findings of Fact" and under subheading "The Specification" quotes various parts of the Specification: None of these are referred to in the Total Final Action. The only parts of the Specification referred to in the Total Final Action are in OA07282004 at

1. page 9 thereof refers to Specification page 3, line 20 to Specification page 4, line 9; and
2. page 11 thereof refers to Specification page 18, line 1-20.

The Board's Decision refers to Specification page 3, line 20 to Specification page 4, line 9; as a subpart of the paragraph bridging pages 7-8 thereof. This is the part of the text in bold font quoted above from the Board's Decision at pages 7-8 under the heading "Findings of Fact" and under subheading "The Specification"

As stated above the Examiner's Answer is essentially identical to the Total Final Action

Since the Board's decision relies on facts that the Total Final Action does not rely on, the Board's Decision is necessarily based on facts that were not part of the Total Final Action. Thus Appellants did not comment on in Appellant's Brief or in Appellants' Replies on how these facts are being used to support a finding on non-enablement.

Appellants should not be required to respond to facts used to support a finding of non-enablement when those facts were not relied on in the Total Final Action to support the rejections for non-enablement for the first time in a Request for Rehearing.

#### **Section 4**

#### **DECISIONS RELIED ON BY THE BOARD THAT WERE NOT CITED BY THE EXAMINER IN THE TOTAL FINAL ACTION OR THE EXAMINER'S ANSWER**

##### **Section 4.1**

##### **DECISIONS CITED BY THE TOTAL FINAL ACTION**

Decisions cited by OA07282004 are:

1. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) at page 6, footnote 2.
2. *In re Angstadt*, 537 F.2d 498, 502-503, 190 USPQ 214, 218 (CCPA 1976) at page 6, footnote 2.
3. *In re Colianni*, 561 F.2d 220, 224, 195 USPQ 150, 153-154 (CCPA 1977) J. Rich at page 6, footnote 2.
4. *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971) at page 6, footnote 3.

5. *Cosden Oil & Chemical Co. v. American Hoechst Corp.*, 543 F. Supp. 522, 555, 214 USPQ 244, 262 (D. Del. 1982) at page 6, footnote 3.
6. *In re Corkill*, 711 F.2d 1496, 1501, 226 USPQ 1005, 1009 (Fed. Cir. 1985) at page 7, footnote 4.
7. *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966) at page 7, footnote 5.
8. *Ex parte Jackson*, 217 USPQ 804, 806 (Bd. App. 1982) at page 10.
9. *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999) at page 10.
10. *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) at page 13.
11. *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971) at page 20.
12. *In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981) at page 20

Decisions cited by the Final Action are:

1. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) at page 9.
2. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) at page 11.

Appellant's Brief and Appellant's Replies rebut how the Total Final Action applied in these decisions. The Board's Decision makes no comments on this rebuttal. Thus it is Appellants' understanding that Appellants' rebuttal overcame the Total Final Rejection's application of these decisions and thus showed that the Total Final Rejection's application of these decisions was legal error.

## **Section 4.2**

### **DECISIONS CITED BY THE BOARD'S DECISION**



1. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) at pages 13, 34.
2. *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997) at page 14.
3. *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1403 (Fed. Cir. 1988), quoting *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976) at pages 15, 35.
4. *Symbol Techs., Inc. v. Opticom, Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) at page 30.
5. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) at page 34.
6. *Plant Genetic Sys. V. DeKalb Genetics Corp.*, 315 F.3d 1335, 1340, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003) at page 35.

### **Section 4.3**

#### **DECISIONS CITED BY THE BOARD'S DECISION BUT NOT CITED BY THE TOTAL FINAL ACTION**

1. *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997).
2. *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1403 (Fed. Cir. 1988).
3. *Symbol Techs., Inc. v. Opticom, Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).
4. *Plant Genetic Sys. V. DeKalb Genetics Corp.*, 315 F.3d 1335, 1340, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003).

### **Section 4.3.1**

The decisions cited by the Board' Decision introduce substantial new arguments not contained in the Total Final Action which effectively makes the Decision on Appeal an action on the merits by the Board acting in its capacity or role as an examiner.

#### **Section 4.4**

#### **DECISIONS CITED BY THE APPELLANT IN APPELLANT'S BRIEF AND APPELLANT'S RELIES**

Appellant cites numerous decisions, but does not cite *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 42 USPQ2d 1001 (Fed. Cir. 1997) or *Symbol Techs., Inc. v. Opticom, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) since these decisions were not referred to in the Total Final Action. These decisions were cited in the Board's Decision for the first time in the prosecution of this Application.

#### **Section 5**

#### **THE BOARD'S DECISION IS PRIMARILY BASED ON *GENENTECH, INC. V. NOVO NORDISK, A/S*, 108 F.3D 1361, 42 USPQ2D 1001 (FED. CIR. 1997) AND *IN RE WRIGHT*, 999 F.2D 1557, 27 USPQ2D 1510 (FED. CIR. 1993)**

#### **Section 5.1**

#### ***GENENTECH, INC. V. NOVO NORDISK*, *A/S*, 108 F.3D 1361, 42 USPQ2D 1001 (FED. CIR. 1997)**

The entire argument of the Board in the Board's Decision based on *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 42 USPQ2d 1001 (Fed. Cir. 1997) is not contained in the Total Final Rejection or any where else in the prosecution of the present application or of the Ancestral Applications. *Genentech* was never cited by the Examiner in the prosecution of the present application or in the Prosecution of the Ancestral Applications. Thus the entire argument of the Board in the Board's Decision based on *Genentech* are new arguments. Appellants should not be required to respond to new arguments for the first time in a Request for Rehearing. To properly respond to these new arguments it may be necessary to cite

1. to court or Board decisions not cited prior to a response to the Board's Decisions;
2. to introduce new facts to rebut these new arguments; and
3. to provide new declarations or affidavits to rebut these new arguments.

For these reasons Appellant's request to return the present application to prosecution should be granted.

## **Section 5.2**

### ***IN RE WRIGHT*, 999 F.2D 1557, 27 USPQ2D 1510 (FED. CIR. 1993)**

The only reference to *In re Wright* in the Total final Action is in the Final action at the end of the paragraph bridging pages 10 and 11 there of which states:

Whether the specification would have been enabling as of the filing date involves consideration of the nature of the invention, the state of the prior art, and the level of skill in the art. The initial inquiry is into the nature of the invention, i.e., the subject matter to which the claimed invention pertains. The nature of the invention becomes the backdrop to determine the state of the art and the level of skill possessed by one skilled in the art. The state of the prior art is what one skilled in the art would have known, at the time the application was filed, about the subject matter to which the claimed invention pertains. A conclusion of lack of enablement means that, based on the evidence regarding each of the factors discussed in the rejection, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

This is a paraphrasing of what *In re Wright* stands for. The Total final Action quotes no direct language from *In re Wright*.

## **Section 5.2.1**

### **REFERENCES TO *IN RE WRIGHT***

## FROM APPELLANTS' BRIEF

Appellant refers to *In re Wright* at BV1 pages 87, 88, 90, 107, 129, 146 and 218 to rebut the Examiner's citation of *In re Wright* in the Final Action. The Board's Decision makes no reference to Appellants' rebuttal. Appellant understands this to mean that the Board agrees that Appellants' argument in regards to *In re Wright* has overcome the Examiner's argument based on *In re Wright*. Sections 5.1.1.1 to 5.2.1.7 quote from Appellants' Brief the Appellants' argument in regards to *In re Wright*.

### Section 5.2.1.1 *In re Wright*

The following language is quoted from BV1 pages 87-88:

The CAFC in *In re Wright*, 27 USPQ2d 1510 (1993) supports Applicants' view that a predictable art is one in which species within the scope of a claim under examination are determinable whether or not a theory of the invention is known as of the filing date of the application under examination. The claims under examination in *In re Wright* are directed to a recombinant vaccine which confers immunity to chickens against a certain type of RNA tumor virus. These claims include in their scope vaccines against the AIDS virus. The CAFC states:

Wright seeks allowance, however, of claims which would provide, in varying degrees, a much broader scope of protection than the allowed claims. 27 USPQ2d 150, 1511.

The CAFC further states:

The Examiner made reference to the difficulty that the scientific community is having in developing generally successful AIDS virus vaccines merely to illustrate that the art was not even today as predictable as Wright suggested it was back in 1983!

No mention is made of the presence or absence of a theory. Thus *In re Wright* shows that an art is unpredictable when persons of skill in the art do not "know how to make"

species that come within the scope of the claims and is predictable when people of skill in the art know how to make species within the scope of the claims based on the teaching of the application under examination.

#### **Section 5.2.1.2**

##### ***IN RE WRIGHT***

The following language is quoted from BV1 pages 90-91:

The CAFC in *In re Wright* citing *In re Hogan* states:

We note, however, that the issue is not what the state of the art is today or what a skilled artisan today would believe, but rather what the state of the art was [as of applicants' filing date] and what a skilled artisan would have believed at that time. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir.), cert denied, 480 U.S. 947 (1987); *In re Hogan*, 559 F.2d 595, 604, 194 USPQ 527, 535 (CCPA 1977). Wright's tendency to employ the present tense often makes it difficult to determine whether Wright is asserting that certain information was known prior to February of 1983 or simply that that information is now known in the art. *In re Wright*, 999 F.2d 1557, 1563 (Fed. Cir. 1993), 27 USPQ1511, 1414 footnote 8.

There is no evidence in the record that a skilled artisan, once they became aware of Applicants' discovery, could not make other species that came within the scope of Applicants' claims with what was known to such artisans prior to Applicants' discovery. The DST AFFIDAVITS (Brief Attachments AM to AO) and affidavits of Brief Attachments AH to AL identify what was known to such artisans many years before Applicants' discovery that such artisans would use as of Applicants' discovery with Applicants' teaching to make such other species

#### **Section 5.2.1.3**

##### ***In re Wright***

The following language is quoted from BV1 page 107:

The Examiner has provided no example of a composition that comes within the scope of Applicants' claims that will work and that cannot be made following Applicants' teaching as of Applicants' earliest filing date as required by *In re Wright* supra 27 USPQ2d 1510, footnote 8 at page 1514, cites *In re Hogan* supra 194 USPQ 527, 533 (CCCPA 1977).

**Section 5.2.1.4**  
***IN RE WRIGHT***

The following language is quoted from BV1 page 129:

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). It is the Examiner's burden to show this and the Examiner has clearly not done so.

**Section 5.2.1.5**  
**REFERENCE TO *IN RE WRIGHT***

The following language is quoted from BV1 page 146

The CCPA in *In re Hogan*, supra, and the CAFC in *In re Wright*, supra, explicitly permit later publications to corroborate the truth of an applicants' teaching. It is not necessary for Applicants to show that the data was generated prior to Applicants' filing date. The CCPA in *In re Angstadt*, supra, clearly states this is not required.

**Section 5.2.1.6**  
**REFERENCE TO *IN RE WRIGHT***

The following language is quoted from BV1 page 208:

As noted above Applicants are not required, to satisfy the enablement requirement, to foresee all species that come

within the scope of their claims when they can be determined without undue experimentation and testing. When the USPTO allows a later claim to a species because of unexpected results, that does not render an earlier allowed genus claim to that species not enabled and invalid. Thus serendipity does not result in lack of enablement. This is consistent with *In re Hogan*, supra, and *In re Wright*, supra, which state that information developed after the filing date of the genus cannot be used to show enablement or lack of enablement.

#### **Section 5.2.1.7**

#### **REFERENCE TO *IN RE WRIGHT***

The following language is quoted from BV1 pages 217-218:

At page 11 of the Final Action the Examiner further states:

The nature of the invention becomes the backdrop to determine the state of the art and the level of skill possessed by one skilled in the art. The state of the prior art is what one skilled in the art would have known, at the time the application was filed, about the subject matter to which the claimed invention pertains. A conclusion of lack of enablement means that, based on the evidence regarding each of the factors discussed in the rejection, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

As described above *In re Wright* is directed to a biotechnology invention and as stated by the Board in *Ex parte Jackson*, supra, it does not apply, to the present application but *In re Angstadt*, supra, and *In re Geerdes*, supra, apply.

.....

For a person of ordinary skill in the art to fabricate the later discovered species it is only necessary to use applicants teaching with what was known by a person of skill in the art at the time of Applicants' discovery. The Examiner has not

stated that the later discovered species cannot be made following applicants teaching with what was known by a person of skill in the art at the time of Applicants' discovery. Thus under *In re Wright*, as discussed above, Applicants have enable[d] (Sic) their claims.

### **Section 5.3**

#### **REFERENCES TO *IN RE WRIGHT* FROM THE BOARDS' DECISION**

##### **Section 5.3.1**

#### **REFERENCE TO *IN RE WRIGHT***

The following language is quoted from the Board's Decision pages 13-14:

"Although not explicitly stated in section 112, to be enabling, the specification of a patent [application] must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). "Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples." *Id.*

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of the enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

*Id.* at 1561-62. In order to carry this burden, the applicant must establish by evidence or arguments that, on the application filing date, a person of ordinary skill in the art would have believed reasonably that applicants' success with a particular species could be extrapolated with a reasonable expectation of success to other species. *Id.* at 1564 ("Wright has failed to establish by evidence or arguments that, in February of 1983, a skilled scientist would have believed reasonably that Wright's success with a particular strain of



an avian RNA virus could be extrapolated with a reasonable expectation of success to other avian RNA viruses").

#### **Section 5.3.2**

##### **REFERENCE TO *IN RE WRIGHT***

The following language is quoted from the Board's Decision pages 27-28:

However, Appellants have not established their proposition that predictability is indicated by the use of empirical approaches, intuition, and serendipity in the research and discovery methodology of scientists. Contrary to this proposition, we regard predictability in the context of enablement as involving a reasonable expectation of success. See *Wright*, 999 F.2d at 1564 ("Wright has failed to establish by evidence or arguments that. . . a skilled scientist would have believed reasonably that Wright's success with a particular strain of an avian RNA virus could be extrapolated with a reasonable expectation of success to other avian RNA viruses").

#### **Section 5.3.3**

##### **REFERENCE TO *IN RE WRIGHT***

The following language is quoted from the Board's Decision page 29:

As rebuttal to a prima facie case of non-enablement, Appellants argue that they "have shown extensive evidence that persons of skill in the art can determine species within the scope of [the claims in this subsection] without undue experimentation" (App. Br., vol. 3, p. 35; see generally App. Br., vol. 3, pts. 1-8). These arguments and evidence are unpersuasive for two fundamental reasons. First, they do not carry Appellants' burden of showing enablement with respect to "the full scope of the claimed invention" as defined by the claims under consideration. *Wright*, 999 F.2d at 1561.

#### **Section 5.3.4**

##### **REFERENCE TO *IN RE WRIGHT***

The following language is quoted from the Board's Decision page 34:

In light of the foregoing, the arguments and evidence presented by Appellants in this appeal have little if any value in

establishing that, on the original application filing date of 22 May 1987, a skilled scientist in this art would have believed reasonably that Appellants' high temperature superconductivity success with the mixed transition metal oxide materials discussed above could be extrapolated with a reasonable expectation of success to other materials. *See Wright*, 999 F.2d at 1564 ("Wright has failed to establish by evidence or arguments that, in February of 1983, a skilled scientist would have believed reasonably that Wright's success with a particular strain of avian RNA virus could be extrapolated with a reasonable expectation of success to other avian RNA viruses").

#### **Section 5.3.6**

#### **REFERENCE TO *IN RE WRIGHT* IN THE BOARD'S DECISION CONCLUSION**

As noted above in Section 5.2 the Total Final Action quotes no particular language from *In re Wright*. The Board's Decision on the other hand quotes specific language and applies this quoted language to make an augment that the Total Final Action did not make. Appellants should not be required to respond an augment that appears for the first time in a decision on appeal. The arguments and citations to specific language from *In re Wright* should have been made no later than in the Final Action so that Appellants would have an opportunity to properly respond to them. Appellants request that prosecution be reopened so that Appellants can have an opportunity to respond by argument, introduction of facts, declarations and affidavits if necessary to respond to these new arguments. Appellants should not be required to respond to new arguments for the first time in a Request for Rehearing. To properly respond to these new arguments it may be necessary to cite

1. to court or Board decisions not cited prior to a response to the Board's Decisions;
2. to introduce new facts to rebut these new arguments; and
3. to provide new declarations or affidavits to rebut these new arguments.

For these reasons Appellant's request to return the present application to prosecution should be granted.

## **Section 6**

### **THE TOTAL FINAL ACTION AND EXAMINER'S ANSWER MADE NO COMMENT ON APPELLANTS' DECLARATION AND AFFIDAVIT EVIDENCE**

#### **Section 6.1**

### **APPELLANTS' BRIEF SPECIFICALLY STATES THE TOTAL FINAL ACTION MADE NO COMMENT ON APPELLANTS' DECLARATION AND AFFIDAVIT EVIDENCE**

The following language is quoted from BV1 page 114:

The Examiner has provided no reason for why the 1.132 Declarations of Mitzi, Tsuei, Dinger and Shaw (Brief Attachments AH, AI, AJ, AK and AL) are not persuasive and the Examiner has made no comment on the DST Affidavits (Brief Attachments AM to AO) or the declaration of Bednorz (Brief Attachment AQ) or the Affidavit of Newns (Brief Attachment AQ).

#### **Section 6.2**

### **APPELLANTS' REPLY BRIEF SPECIFICALLY STATES THE EXAMINER'S ANSWER MADE NO COMMENT ON APPELLANTS' DECLARATION AND AFFIDAVIT EVIDENCE**

Appellants' Reply states at page 5, lines 4-5, "[t]he Examiners' Answer is essentially verbatim copied from the Office Action dated 07/28/2004 and the Final Action." Thus the Examiner's Answer adds no new facts, decisions or arguments not found in the Total Final Action.

#### **Section 6.3**

### **THE BOARD'S DECISION ACKNOWLEDGES THAT THE EXAMINER'S ANSWER MADE NO COMMENT ON APPELLANTS' DECLARATION AND AFFIDAVIT EVIDENCE**

The following language is quoted from BD, page 17:

The Examiner has not explained why this evidence fails to show enablement for the specific claims under review (Ans. 8-27). Instead, the Examiner characterizes Appellants' evidence as failing to establish that the Specification enables the full scope of the rejected claims generally (*id.*). The Examiner explicitly criticizes Appellants' affidavit evidence as "conclusory only" (Ans. 15) although no specific reasons are given for considering the affidavits to be "conclusory only" with respect to the claims discussed in this subsection.

#### **Section 6.4**

Appellants disagree that the language quoted from Board's Decision in Section 6.3 accurately represents the facts.

Appellants' Reply page 3, lines 3-7 states:

The Examiner's Answer is essentially verbatim copied from the Office Action dated 07/28/2004 and the Final Action. The Examiner's Answer from page 5, line 12 to page 20, line 6 is essentially copied from the Office Action of 07/28/2004. The Examiner's Answer from page 20, line 7 to page 29, line 11, is essentially copied from the Final Action.

Thus Appellants submit that the referred to comment "conclusory only" from page 15 of the Examiner's Answer is referring only to Appellants' affidavits submitted prior to OA07282004 and not to what Appellants have referred to as the DST Affidavits (Brief Attachments AM to AO) which were submitted after OA07282004 or the declaration of Bednorz (Brief Attachment AQ), which was submitted after the Final Action, or the Affidavit of Newns (Brief Attachment AQ) which was submitted after the Final Action.

Appellants specifically noted this in Appellants Reply at page 6, lines 1-20, which states (Text in bold square brackets is added for clarity):

At page 12 of the Examiner's Answer, the first sentence of the last paragraph states "[t]he Applicants also have submitted three affidavits attesting to the applicants' status as the discoverers of materials that superconduct > 26°K." At page 15 of the Examiner's Answer, lines 14-15 states "3 affiants." As stated in the Brief in this passage the Examiner incorrectly states Applicants submitted three affidavits. Prior to the Office Action of

07/28/2004 [which is incorporated into the Final Action at page 4 thereof] Applicants submitted the five affidavits of Brief Attachments AH, AI, AJ, AK, AL of Mitzi, Dinger, Tsuei, Shaw and Duncombe, respectively. Subsequent to the Office Action of 07/28/2004 Applicants submitted the expanded affidavits of Shaw, Tsuei and Dinger of Brief Attachments AM, AN and AO, respectively **[referred to in Appellants' Brief as the DST Affidavits]**. The expanded affidavits set forth particular facts to support the conclusions that all superconductors based on Applicants' work behave in the same way and that one skilled in the art can make those superconductors without undue experimentation. In the Answer the Examiner has not responded to these affidavits. In addition subsequent to the Office Action of 07/28/2004 Applicants submitted the Newns Affidavit (Brief Attachment AP) and declaration of co-inventor Georg Bednorz (Brief Attachment AQ). **[Appellants note that the Newns Affidavit and the Bednorz Declaration were submitted in response to new arguments in the Final Action and were thus submitted subsequent to the Final Action]** In the Answer the Examiner has not responded to the Newns Affidavit or the Bednorz declaration. The Examiner has not rebutted this evidence (including the other evidence submitted by Applicants) and thus has not made a prima facie case of lack of enablement.

## **Section 7**

### **THE BOARD'S DECISION MAKES ADVERSE COMMENTS ON APPELLANTS' DECLARATION AND AFFIDAVIT EVIDENCE**

#### **Section 7.1**

#### **REFERENCE TO BEDNORZ AFFIDAVIT OF RECORD (APP. BR., VOL. 5, EVIDENCE APPENDIX, ATTACHMENT AQ) QUOTED FROM THE BOARD'S DECISION PAGE 28**

The Board's Decision at page 28 states:

With respect to the Examiner's reliance on the "Exploring Superconductivity" article as evidencing predictability, Appellants attempt to undermine this evidence via the Bednorz affidavit of record (App. Br., vol. 5, Evidence Appendix, Attachment AQ) which addresses the Bednorz quotation in this article (App. Br., vol. 1, p. 209). Significantly, the Bednorz affidavit fails to address the article disclosure which states that "there is no accepted theory to explain the high-temperature

[superconductivity] behavior of this type of compound" ("Exploring Superconductivity", last para.). The absence of such a theory supports the Examiner's unpredictability position.

Appellants note that the only affidavit explicitly referenced here is the Declaration Bednorz (Brief Attachment AQ). As noted above, neither the Total Final Rejection nor the Examiner's Answer make any comment on this affidavit. The language for the Board's Decision is the first time any comment has been made on this affidavit in the prosecution of this application

### Section 7.2

#### **IN THE BOARD'S DECISION MAKE A COMMENT ON NEWNS AFFIDAVIT OF RECORD (APP. BR., VOL. 5, EVIDENCE APPENDIX, ATTACHMENT AP), BEDNORZ AFFIDAVIT QUOTED FROM BOARD'S DECISION PAGES 27-28**

The Board's Decision states at page 27-28:

Appellants argue that the Schuller article actually supports their predictability position and cite the Newns affidavit of record (App. Br., vol. 5, Evidence Appendix, Attachment AP) as support for this argument (App. Br., vol. I, p. 195-208). Specifically, Appellants urge that their predictability position is supported by Schuller's reference to new superconductor discoveries as based largely on empirical approaches, intuition, and serendipity since these bases are typically used by scientists during the discovery process as evidenced by the Newns affidavit (*id.*). However, Appellants have not established their proposition that predictability is indicated by the use of empirical approaches, intuition, and serendipity in the research and discovery methodology of scientists. Contrary to this proposition, we regard predictability in the context of enablement as involving a reasonable expectation of success. See *Wright*, 999 F.2d at 1564 ("Wright has failed to establish by evidence or arguments that... a skilled scientist would have believed reasonably that Wright's success with a particular strain of an avian RNA virus could be extrapolated with a reasonable expectation of success to other avian RNA viruses")

With respect to the Examiner's reliance on the "Exploring Superconductivity" article as evidencing predictability, Appellants attempt to undermine this evidence

via the Bednorz affidavit of record (App. Br., vol. 5, Evidence Appendix, Attachment AQ) which addresses the Bednorz quotation in this article (App. Br., vol. 1, p. 209). Significantly, the Bednorz affidavit fails to address the article disclosure which states that "there is no accepted theory to explain the high-temperature [superconductivity] behavior of this type of compound" ("Exploring Superconductivity", last para.). The absence of such a theory supports the Examiner's unpredictability position.

Appellants note that the only affidavit explicitly referenced here is the Affidavit of Newns (Brief Attachment AP). As noted above the neither the Total Final Rejection nor the Examiner's Answer make any comment on this affidavit. The language for the Board's Decision is the first time any comment has been made on this affidavit in the prosecution of this application

### **Section 7.3**

#### **THE BOARD'S DECISION MAKE A COMMENT ON AFFIDAVITS OF RECORD BY MITZI, DINGER, TSUEI, SHAW, DUNCOMBE, NEWNS, AND BEDNORZ (SEE APP. BR., VOL. 5, EVIDENCE APPENDIX, ATTACHMENTS AH TO AR).NEWNS AFFIDAVIT, BEDNORZ AFFIDAVIT**

The Board's Decision pages 33-34 states:

As support for their enablement position, Appellants additionally rely on the affidavits of record by Mitzi, Dinger, Tsuei, Shaw, Duncombe, Newns, and Bednorz (*See* App. Br., vol. 5, Evidence Appendix, Attachments AH to AR). The Newns and Bednorz affidavits do not support Appellants' enablement position for the same previously-given reasons that they do not support Appellants' predictability position. The remaining affidavits share common deficiencies. The Shaw affidavit (App. Br., vol. 5, Evidence Appendix, Attachment AM) is illustrative. In this affidavit, Shaw states that persons of ordinary skill in this art are capable of fabricating ceramic materials exhibiting high temperature superconductivity by using principles of ceramic fabrication known in the prior art (*see e.g.*, paras. 8, 11, 49, 50). Such statements do not evince enablement for reasons explained earlier. That is, all the claims under consideration are not limited to high temperature superconductive ceramic materials. Moreover, it is the

Specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. *Genentech*, 108 F.3d at 1366. The affidavits relied upon by Appellants do not explain how the Specification supplies novel aspects of Appellants' invention to thereby enable the full scope of the claims under consideration.

Appellants note that the only affidavit explicitly referenced here is the Affidavit of Shaw (Brief Attachment AM). This is one of the DST Affidavits. As noted above the neither the Total Final Rejection nor the Examiner's Answer make any comment on this affidavit. The language for the Board's Decision is the first time any comment has been made on this affidavit in the prosecution of this application.

### **Section 8**

#### **BOARD'S DECISION PRIMARILY RELIES ON AN ARGUMENT NOT MENTIONED IN THE TOTAL FINAL ACTION OF IN THE EXAMINER'S ANSWER**

Appellants note that for the most part the argument in the Board's Decision does not refer to the Examiner's argument in the Total Final Rejection and the Examiner's Answer and does not refer to the argument presented by the Appellant in Appellants' Brief and Appellants' Replies. This is evident by the fact that the Board's Decision makes no significant reference to those arguments. Since the Board's Decision makes no significant reference to the arguments presented in the Total Final Rejection and the Examiner's Answer and in Appellants' Brief and Appellants' Replies, Appellants' arguments for why their claims are enabled have apparently overcome and have prevailed over the Examiner's arguments for why the claims, for which, the Board has sustained the rejections for lack of enablement, are not enabled. From the Board's Decision, since the Board is still of the view that certain claims ( the claims for which the Board's Decision has sustained the Examiner's rejection) are not enabled, the Board's Decision has introduced new arguments to support that



view that were not made in the Total Final Action or the Examiner's Answer. For example, Appellant's Brief and Appellants' Replies make reference to many legal authorities, including two Board of appeal decisions, in particular to the Board's precedential decision *Ex parte Jackson*, 217 USPQ 804 (Bd. App. 1982) in support of Appellants' argument. The Board's Decision makes no comment on Appellants' application of these legal authorities.

The Board's Decision states at page 34:

Appellants rely on numerous legal authorities in support of their enablement viewpoint. For the most part, however, these authorities and Appellants' arguments regarding them are not concerned with the pivotal question of why Appellants' Specification would have led an artisan to reasonably believe that Appellants' success with the previously noted mixed transition metal oxides could be extrapolated with a reasonable expectation of success to the other materials embraced by the claims of this subsection. Nevertheless, it is important that we clarify misimpressions created by Appellants' arguments regarding certain legal authorities.

The main thrust of the argument of the Board's Decision is summaries in the paragraph quoted above. Neither the Total Final Action nor the Examiner's Answer refer to or argue "extrapolat[ion] with a reasonable expectation of success to the other materials embraced by the claims." This is entirely a new line or augment that appears for the first time in the prosecution of the present application in the Board's Decision. Appellants should not be required to respond to new arguments for the first time in a Request for Rehearing. To properly respond to these new arguments it may be necessary to cite

1. to court or Board decisions not cited prior to a response to the Board's Decisions;
2. to introduce new facts to rebut these new arguments; and
3. to provide new declarations or affidavits to rebut these new arguments.

For these reasons Appellant's request to return the present application to prosecution should be granted.

## **Section 9**

### **CONCLUSION**

For the reasons given in Sections 1-8 Appellants request that prosecution be reopened.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

/Daniel P Morris/  
Dr. Daniel P. Morris, Esq.  
Lead Attorney  
Reg. No. 32,053  
(914) 945-3217

Yeen C. Tham  
Reg. No. 63,169  
(914) 945-2939

IBM CORPORATION  
Intellectual Property Law Dept.  
P.O. Box 218  
Yorktown Heights, New York 10598

## DECLARATION OF ALVIN JOSEPH RIDDLES

I, Alvin Joseph Riddles, declare that:

1. I am an attorney admitted to the Bar of the State of New York.
2. I am admitted to practice before the United States Patent and Trademark Office (USPTO) as a patent attorney.
3. My Registration Number initially as a patent agent and later as patent attorney before the USPTO is 17862.
4. I have been practicing before the USPTO initially as a patent agent and later as patent attorney since about 01/31/1955.
5. My address as recorded in the list of agents and attorneys registered to practice before the USPTO is Candlewood Isle P O Box 34, New Fairfield, CT 06812.
6. I attended a presentation made by Michael R. Flemming, Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, at a luncheon meeting of the New York Intellectual Property Law Association on September 16, 2009 (NYIPL Meeting). The presentation was entitled "Appellate Practice and Recent Developments Board of Patent Appeals and Interferences." Judge Flemming handed out a copy of his presentation. A copy is attached to this Declaration as Attachment A.
7. I have the following recollection of Judge Flemming's presentation about decisions on appeal by the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (the Board):
  - i. During his presentation Judge Flemming stated that if a decision on appeal of the Board sustains an appealed rejection of a final office action for different reasons than stated in the final office action; that should be considered new grounds of rejection permitting the appellant

to request and be granted that prosecution of the application be reopened.

- II. Judge Flemming further stated that in a decision on appeal the panel of the Board in its appellate capacity is supposed to be considering:
    - a. the facts, decisions and arguments that the examiner gave in support of the rejection in the final office action and in the examiner's answer,
    - b. the facts, decisions and arguments that the appellant gave in the brief and reply in support of why the examiner made an error in the rejection in the final office action, and
    - c. based on items a and b deciding whether to sustain the examiner's rejection or to reverse the examiner's rejection.
  - III. Judge Flemming further stated that in a decision on appeal if the panel of the Board relies on the facts, decisions and arguments not referred in the final office action and in the examiner's answer, the panel of the Board is acting in such a situation as an examiner and prosecution of the application should be reopened at the request of the appellant. In this situation the panel of the Board is acting in the capacity of an examiner and has effectively withdrawn the final rejection.
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- 8. The copy of Judge Flemming's presentation in Attachment A does not explicitly state what is stated above in item 7 and subparts I, II, III and IV thereof, but this is my recollection of what Judge Flemming stated.
  - 9. Judge Flemming could be considered to have indicated by his statements that this is how he would like the Board to function in the future.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements made jeopardize the validity of the application or patent issued hereon.

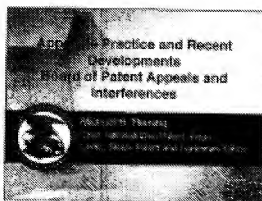
Date 11/9/09

By Alvin Joseph Riddles  
Alvin Joseph Riddles

DECLARATION OF ALVIN JOSEPH RIDDLES

Page 3 of 19

## **ATTACHMENT A**




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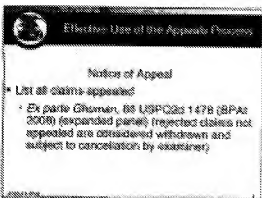
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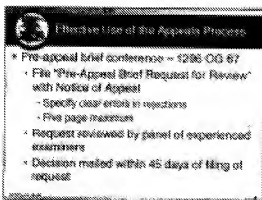
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 Preparing Appeal Brief Practice Tips

- Not required but consider providing:
  - Jurisdictional statement
  - Table of contents
  - Table of authorities

2009-10-09

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 Preparing Appeal Brief Practice Tips

- Arguments should be concise and focused
  - Identify facts in dispute in separate section
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  - Explain why examiner erred

2009-10-09

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 Preparing Appeal Brief Practice Tips

- Arguments directed to why examiner erred
  - *Ex parte Behlme*, Appeal 2009-044690, (BPAI App. 10, 2009) (informative opinion)

(\*Appellants do not present any arguments to explain why the Examiner's explicit fact finding is in error)

2009-10-09

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 **Preparing Appeal Brief Practice Test**

- Clearly point out **material facts** relevant to why examiner erred
- Clearly point out **claim language** relevant to why examiner erred

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 **Preparing Appeal Brief Practice Test**

- Proper claim construction
  - *Ex parte Carlin*, Appeal No. 2007-3672, (BPAI February 3, 2009) (Precedential opinion) (means plus function limitation where specification fails to disclose algorithm for programming general purpose computer to perform specified function)

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 **Preparing Appeal Brief Practice Test**

- *Ex parte Miyazaki*, 45 USPQ2d 1207 (BPAI 2009) (rependent claim) (Precedential opinion)

1. Facts...

1. Functional features not claimed in the claim language of § 112, § 6 (i.e., "means plus function")
2. Specification discloses no more than claimed function

Under the reasoning of *In re Johnston* 2011-0107 (CAFC 2011-0107), the claim is construed to cover all structures that perform the claimed function, and the scope of construction fails to support the claim as recited by § 112, § 1)

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This image shows a single sheet of white paper with horizontal blue or grey ruling lines. The lines are evenly spaced and run across the width of the page. There are approximately 20 lines visible. The paper appears to be from a notebook or a standard ruled document.

 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Preparation, Preparation and Preparation
  - Remember the panel has thoroughly read and discussed the case before the hearing
  - You only have 20 minutes

202-222-2222

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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Identify your best argument in the brief
  - Do not attempt to discuss every argument in the brief
  - Highlight the portions of the specification and the claim language that support your best arguments
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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Identify the weakness of your case
  - Be prepared to address this weakness directly
  - Be sure you are making arguments that are made in the brief

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  - Be prepared to address this weakness directly
  - Be sure you are making arguments that are made in the brief

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    1. Appellant's distinguishing feature as disclosed
    2. Appellant's distinguishing claim limitations
    3. Prior art features and how they do not meet the claim limitations
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 **Practice Tips for Oral Argument**

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  - Visual Aids
    1. Determine if they are needed
    2. Even if they are needed, use only a small number
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    4. Make sure that the Visual Aids serve in meeting the objectives

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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Court reporter will record and transcribe argument
    - Prepare and give to reporter a list of technical terms

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 Practice Tips for Oral Argument

- Oral argument presentation

**BE ON TIME**

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 Practice Tips for Oral Argument

- Oral argument presentation
  - If the application on appeal is available to the public, the oral argument is open to the public.

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 Practice Tips for Oral Argument

- Oral argument presentation
  - View yourself as an Educator
  - Avoid overt emotions - you are not arguing before a jury
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  - Avoid speaking too quickly

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### Practice Tips for Oral Argument

- Questions
  - Be prepared
  - Do not view the Judge who is asking the question as an adversary to your appeal
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  - Do not deny the undersable - you only lose credibility

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### Practice Tips for Oral Argument

- Client attendance
  - Your client is welcome
  - Always introduce your client at the beginning of your presentation
  - Counsel your client not to interrupt or interject comments

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### Practice Tips for Oral Argument

- Conclusion
  - Be sure that you have a compelling reason to request an oral argument
  - Be prepared to answer questions about the prior art and Appellant's claims and specification
  - Remember that you have a limited amount of time
  - Relax and present your case in conversational tones

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 **Recent Trends in Appeal Briefs Filed**

- **Major Accomplishments - Ex Parte Appeals**

**5289 Ex Parte Appeal Decisions**  
Oct 2008 - Jul 2009  
an increase of  
**37.6%**  
over the total Ex Parte Appeal Decisions  
Oct 2007 - Jul 2008

2009-1008

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 **Recent Trends in Appeal Briefs Filed**

**Challenge to Provide Timely Decisions**

**Workload Increase: Docketed Appeals**

FY2007 Actual	FY2008 Actual	FY2009 Projected
4,039	6,585	14,500
	+ 37.6%	+ 127%

2009-1008

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 **Recent Trends in Appeal Briefs Filed**

**Timely Decisions**

- Hiring of New Judges
- Expansion of the Patent Attorney Program
- Improving Speed and Quality of BPAI Processes

2009-1008

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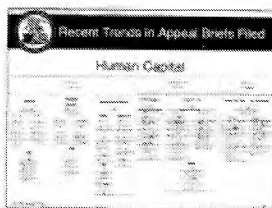
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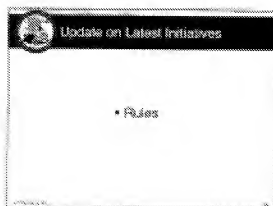
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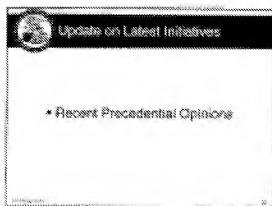
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MICHAEL R. FLEMING  
CHIEF ADMINISTRATIVE PATENT JUDGE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
UNITED STATES PATENT AND TRADEMARK OFFICE

Mr. Fleming was appointed on May 1, 2005 as the Chief Administrative Patent Judge to the Board of Patent Appeals and Interferences. From May 1, 1994 to May 1, 2005, Mr. Fleming served as an Administrative Patent Judge on the Board. Mr. Fleming has experience in dealing with ex parte appeals involving the electrical arts and interference proceedings.

Mr. Fleming received a Bachelor of Science in Electrical Engineering from Virginia Polytechnic Institute and State University in 1978. He received a Master of Science in Electrical Engineering from George Washington University with emphasis in computers in 1982. He received a Juris Doctor from George Mason University Law School in 1986. He was admitted to the Virginia State Bar in 1986.

Mr. Fleming worked briefly as an electrical engineer at Naval Facilities Engineering Command and then joined the U. S. Patent and Trademark Office as a patent examiner in 1981. He received an Examiner's Master rating in computer arts in 1984 and became a primary examiner with full signatory authority in 1985. He became a supervisory primary examiner in 1990 for Art Unit 2308 in the complex art area of computer processing using artificial intelligence.

Mr. Fleming received the Norman P. Morgenstern Award and the Department of Commerce's Bronze Medal. Mr. Fleming was awarded the Department of Commerce's Gold Medal for his participation in the creation of the Examination Guidelines for Computer Related Inventions which provided major improvement in examining quality and consistency.

## DECLARATION OF DANIEL P. MORRIS

I, Daniel P. Morris, declare that:

1. I am an attorney admitted to the Bar of the State of New York.
2. I am admitted to practice before the United States Patent and Trademark Office (USPTO) as a patent attorney.
3. My Registration Number as a patent attorney before the USPTO is 32,053.
4. I have been practicing before the USPTO as a patent attorney since 12/13/1985.
5. My address as recorded in the list of agents and attorneys registered to practice before the USPTO is P. O. Box 218, Yorktown Heights, NY 10598.
6. I attended a presentation made by Michael R. Flemming, Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, at a luncheon meeting of the New York Intellectual Property Law Association on September 16, 2009 (NYIPL Meeting). The presentation was entitled "Appellate Practice and Recent Developments Board of Patent Appeals and Interferences." Judge Flemming handed out a copy of his presentation. A copy is attached to this Declaration as Attachment A.
7. I have the following recollection of Judge Flemming's presentation about decisions on appeal by the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (the Board):
  - i. During his presentation Judge Flemming stated that if a decision on appeal of the Board sustains an appealed rejection of a final office action for different reasons than stated in the final office action that should be considered new grounds of rejection permitting the appellant

to request and be granted that prosecution of the application be reopened.

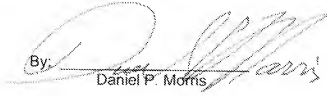
- II. Judge Flemming further stated that in a decision on appeal the panel of the Board in its appellate capacity is supposed to be considering:
    - a. the facts, decisions and arguments that the examiner gave in support of the rejection in the final office action and in the examiner's answer,
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9. Judge Flemming could be considered to have indicated by his statements that this is how he would like the Board to function in the future.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements made jeopardize the validity of the application or patent issued thereon.

Date:

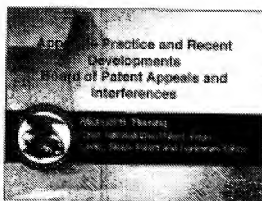
Nov. 16, 2009

By:

  
Daniel P. Morris



## ATTACHMENT A




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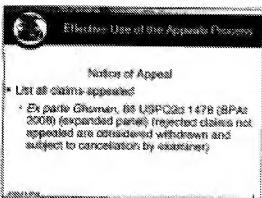
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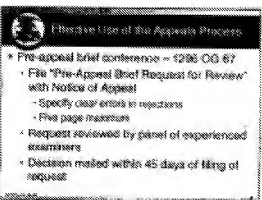
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 **Preparing Appeal Brief Practice Tips**

- Not required but consider providing:
  - Jurisdictional statement
  - Table of contents
  - Table of authorities

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 **Preparing Appeal Brief Practice Tips**

- Arguments should be concise and focused
  - Identify facts in dispute in separate section
  - Identify pivotal claim language and explain resulting claim scope
  - Explain why examiner erred

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 **Preparing Appeal Brief Practice Tips**

- Arguments directed to why examiner erred
  - *Ex parte Behrme*, Appeal 2009-004690, (BPAI App. 10, 2009) (informative opinion)

(\*Appellants do not present any arguments to explain why the Examiner's explicit fact finding is in error)

2009.03.08

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 **Preparing Appeal Brief Practice Test**

- Clearly point out **material facts** relevant to why examiner erred
- Clearly point out **claim language** relevant to why examiner erred

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 **Preparing Appeal Brief Practice Test**

- Proper claim construction
  - Ex parte Carlin, Appeal No. 2007-3672, (BPAI February 3, 2009) (Precedential opinion) (means plus function invention infields where specification fails to disclose algorithm for programming general purpose computer to perform specified function)

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 **Preparing Appeal Brief Practice Test**

- Ex parte Miyazaki, 45 USPQ2d 1207 (BPAI 2009) (rependent prior art) (Precedential opinion)
  - Facts...
    - Functional features not claimed in the prior art of § 112, § 6 (i.e., "means plus function")
    - Specification discloses no more than claimed function

Under the reasoning of *In re Gostkowski*, 42 Fed. Cl. 686 (2005), 358 F.3d 1338, 1342, the claim is construed to give all structures that perform the claimed function, and the scope of claim is limited to support the claim as recited by § 112, § 1.

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 **Preparing Appeal Brief Practice Tips**

- **KSR considerations**
  - Ex parte KSR, 55 USPQ2d 1116 (BPAI 2000) recognized patent (procedural) appeal can succeed in the art would anticipate success in substantiating one species for its genus when the genus performs a limited number of species
  - Ex parte Invention, Appeal No. 2001-4493 (BPAI vs. Central), 2001-4493 (BPAI, July 23, 2000) recognized patent (procedural) appeal for anticipation, it must be shown that use of ordinary skill would have had some reason to modify a known product in the fashion claimed

USPTO

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 **Preparing Appeal Brief Practice Tips**

- **Ex parte Jelle, 50 USPQ2d 1008 (BPAI 2000)**  
 (separated panels) (procedural) appeal  
 (declaration) evidence of non-obviousness
  - variation exists between claimed subject matter and evidence
  - evidence should be free to anticipate any aesthetic aspects of claimed invention
  - element established by machine shows not given unless significant need established by evidence that need was recognized by those of ordinary skill in the art

USPTO

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 **Practice Tips for Oral Argument**

- **Oral argument preparations**
  - **Overall objective**
    - Explain Appellant's disclosed invention
    - Show how the claims cover the disclosed invention
    - Show how the claims distinguish over the prior art

USPTO

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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Preparation, Preparation and Preparation
  - Remember the panel has thoroughly read and discussed the case before the hearing
  - You only have 20 minutes

202-222-6666

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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Identify your best argument in the brief
  - Do not attempt to discuss every argument in the brief
  - Highlight the portions of the specification and the claim language that support your best arguments
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 **Practice Tips for Oral Argument**

- Oral argument preparations
  - Identify the weakness of your case
  - Be prepared to address this weakness directly
  - Be sure you are making arguments that are made in the brief

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  - Court reporter will record and transcribe argument
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 Practice Tips for Oral Argument

- Oral argument presentation

**BE ON TIME**

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 Practice Tips for Oral Argument

- Oral argument presentation
  - If the application on appeal is available to the public, the oral argument is open to the public.

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### Practice Tips for Oral Argument

- Client attendance
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### Practice Tips for Oral Argument

- Conclusion
  - Be sure that you have a compelling reason to request an oral argument
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**5289 Ex Parte Appeal Decisions**  
Oct 2008 - Jul 2009  
an increase of  
**37.6%**  
over the total Ex Parte Appeal Decisions  
Oct 2007 - Jul 2008

2009-1008

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**Recent Trends in Appeal Briefs Filed**

**Challenge to Provide Timely Decisions**

**Workload Increase: Docketed Appeals**

FY2007 Actual	FY2008 Actual	FY2009 Projected
4,039	6,386	14,500
	+ 37.6%	+ 127%

2009-1008

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**Recent Trends in Appeal Briefs Filed**

**Timely Decisions**

- Hiring of New Judges
- Expansion of the Patent Attorney Program
- Improving Speed and Quality of BPA Processes

2009-1008

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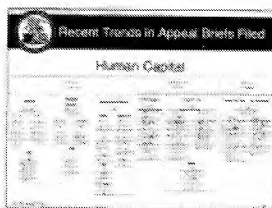
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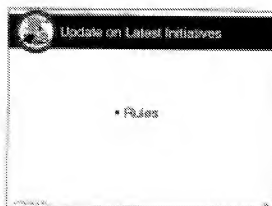
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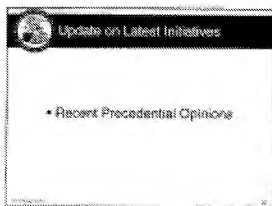
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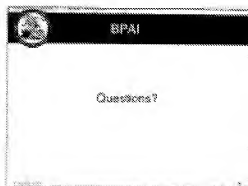
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MICHAEL R. FLEMING  
CHIEF ADMINISTRATIVE PATENT JUDGE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
UNITED STATES PATENT AND TRADEMARK OFFICE

Mr. Fleming was appointed on May 1, 2005 as the Chief Administrative Patent Judge to the Board of Patent Appeals and Interferences. From May 1, 1994 to May 1, 2005, Mr. Fleming served as an Administrative Patent Judge on the Board. Mr. Fleming has experience in dealing with ex parte appeals involving the electrical arts and interference proceedings.

Mr. Fleming received a Bachelor of Science in Electrical Engineering from Virginia Polytechnic Institute and State University in 1978. He received a Master of Science in Electrical Engineering from George Washington University with emphasis in computers in 1982. He received a Juris Doctor from George Mason University Law School in 1986. He was admitted to the Virginia State Bar in 1986.

Mr. Fleming worked briefly as an electrical engineer at Naval Facilities Engineering Command and then joined the U. S. Patent and Trademark Office as a patent examiner in 1981. He received an Examiner's Master rating in computer arts in 1984 and became a primary examiner with full signatory authority in 1985. He became a supervisory primary examiner in 1990 for Art Unit 2308 in the complex art area of computer processing using artificial intelligence.

Mr. Fleming received the Norman P. Morgenstern Award and the Department of Commerce's Bronze Medal. Mr. Fleming was awarded the Department of Commerce's Gold Medal for his participation in the creation of the Examination Guidelines for Computer Related Inventions which provided major improvement in examining quality and consistency.